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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,586	02/24/2004	Glenn Pencer	CDM:8525.9999	4341

152 7590 09/28/2006

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EXAMINER

CHIU, RALEIGH W

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,586

Applicant(s)

PENCER, GLENN

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) 17-20 is/are allowed.
6) ☒ Claim(s) 1-16, 21 and 22 is/are rejected.
7) ☒ Claim(s) 23-35 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC §§ 102 and 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 10-14, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bigornia (USPN 5,284,343).

Regarding claims 10-14 and 21, Figure 5 of Bigornia shows a hockey puck with its outer portion having light and dark colors. See also column 6, lines 11-23.

Regarding claim 22, the presence of a lighter color on the Bigornia pucks shown in Figure 5 is considered to inherently reduce the puck's visibility compared to an all-black puck.

Regarding applicant's amendment to claims 10 and 22, the Bigornia puck clearly has the same size and shape of conventional regulation ice hockey puck. Further, Bigornia teaches the concept of using lighter-than-normal pucks for less-experienced players and adding weight as the players advance their way up to the standard puck. See column 5, lines 42-55. After players continue to practice and advance their way up to the standard weight puck, it would have been obvious to one of ordinary skill in the art to place enough weight into the

Bigornia puck to match a conventional hockey puck for actual game play.

3. Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Keating (USPN 5,184,820).

Regarding claims 10-12, Figure 4 of Keating shows a puck with first and second outer portions 16,18 of different colors. Also, see column 2, lines 51-63.

Regarding the amendment to claim 10, puck body 16 has the same size, shape and weight of a conventional regulation ice hockey puck. See column 1, lines 42-44. Although applicant argues that Keating has additional projections, the breadth of claim 10 does not preclude additional elements. Further, outer portion 16 has a relatively dark color (traditional black puck) and outer portion 18 has a relatively light color (fluorescent orange or green); any color is considered to be relatively light when compared to black. Applicant argues that Keating's Figure 4 embodiment teaches away from the present invention since the band is intended to enhance rather than reduce the visibility of the puck, but it is noted here that such a limitation is absent from the claim. The specification is not the measure of invention and limitations contained therein cannot be read into the claims for the purpose of avoiding the prior art.

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4. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating as applied above.

Regarding claims 13-15, Keating teaches the concept of providing a fluorescent band different from the black color of the puck to provide higher visibility of the puck. See column 3, lines 4-16. Although Keating does not explicitly use white, one of ordinary skill in the art would realize that white provides the most contrast with black and it would have been obvious to one of ordinary skill in the art to use any contrasting color different from the black color of the puck to provide the desired enhance visibility.

Regarding claim 16, band 18 is considered to be an annulus. See Figure 4 of Keating.

5. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bigornia as applied above in view of U.S. Patent Number 3,117,788 (Buonanno *et al.*)

Regarding claims 1-4 and 6-8, Bigornia and Buonanno show hockey pucks with outer portions having dark and light colors in different ratios. A person having both types of pucks is considered to have the claimed kit. Further the specific contrasting color is not deemed to be critical.

Applicant argues that there are no reasons why a person would in fact be motivate to have both types of pucks. However,

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it is old and well-known in the art for a hockey player to purchase any type of puck he desires. Because Buonanno provides a puck having ready visibility, it would have been obvious to one of ordinary skill to use such a puck if such a characteristic were desired for game play. Similarly, it would have been obvious to one of ordinary skill to purchase a Bigornia puck in order to help a player analyze shots and spin during practice.

6. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bigornia and Buonanno as applied above in view of U.S. Patent Application Publication Number 2003/0216199 (Summerfield).

Regarding claims 5 and 9, Summerfield discloses a white hockey puck. See paragraph [0018]. A person having pucks disclosed by Bigornia, Buonanno and Summerfield is considered to have the claimed kit.

As similarly set forth above, it would have been obvious for a person having a Bigornia puck and a Buonanno puck to also purchase a Summerfield puck in order to allow him to monitor game play conditions.

Although applicant argues that Summerfield was published after his priority date, Summerfield has priority which antedates applicant's.

Although applicant argues that Summerfield does not disclose a puck which would remain white under all temperature conditions, such a limitation is not found in the claims.

Allowable Subject Matter

7. Claims 17-20 are allowed.
8. Claims 23-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif

17 September 2006